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HRW

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Dial A Mattress Operating Corp.

Serial No. 74/706,632

Arthur L. Plevy of Buchanan Ingersoll P.C. for Dial A
Mattress Operating Corp.

Chad M. Smith, Trademark Examining Attorney, Law Office 104
(Sidney Moskowitz, Managing Attorney).

Before Seeherman, Hohein and Wendel, Administrative
Trademark Judges.

Opinion by Wendel, Administrative Trademark Judge:

Dial A Mattress Operating Corp. has filed an
application to register the mark 1-800-THE SOFA for
"providing same day or within two hour delivery for
telephone shop at home services via a toll-free telephone
number, in the field of convertible bedding with the term
convertible bedding being defined to encompass convertible

sofas, convertible couches, convertible divans, sofa-beds, and other convertible seating."¹

The application was originally filed as an intent-to-use application seeking registration on the Principal Register. Registration was refused under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that the mark was merely descriptive. Applicant subsequently filed an amendment to allege use and requested that the application be considered as one seeking registration on the Supplemental Register. Registration now stands finally refused under Section 23 of the Trademark Act, 15 U.S.C. § 1091, on the ground that the mark is incapable of identifying applicant's services and distinguishing them from those of others.

The refusal has been appealed and applicant and the Examining Attorney have filed briefs. An oral hearing was not requested.

The Examining Attorney maintains that the non-literal portion of applicant's proposed mark, the term 1-800, is a toll-free telephone area code with no trademark function and that the literal portion, THE SOFA, is generic for

¹ Serial No. 74/706,632, filed July 27, 1995, based on an allegation of a bona fide intent to use the mark in commerce. An amendment to allege use was filed June 16, 1997, setting forth a first use date of August 30, 1995 and a first use in commerce date of March 19, 1996.

applicant's retail store services in the field of convertible bedding. Thus, registration has been refused on the basis that the proposed mark as a whole is incapable of functioning as a source identifier.

The Examining Attorney in his brief relies directly upon the Board's decision in *In re Dial A Mattress Operating Corp.*, 52 USPQ2d 1910 (TTAB 1999), which issued in the interim between applicant's filing of its brief and the Examining Attorney's filing of his brief. Although applicant had the opportunity to address the applicability to this case of the Board's holdings in *Dial A Mattress*, it chose not to file a reply brief. We have, of course, fully considered the arguments made by applicant in its principal brief.

In the *Dial A Mattress* case, the present applicant sought registration of the designation 1-888-M-A-T-R-E-S-S on the Principal Register for telephone shop-at-home retail services in the field of mattresses. Although the issues there involved not only genericness, but also mere descriptiveness under Section 2(e)(1) and acquired distinctiveness under Section 2(f), only the generic issue is relevant here, since registration is being sought on the Supplemental Register. Without going into a detailed

recapitulation of the Board's reasoning in *Dial A Mattress*, we cite the Board's holding that

...if the mark sought to be registered is comprised solely of the combination of a designation (such as a toll-free telephone area code) which is devoid of source-indicating significance, joined with matter which, under the *Ginn* two-part test, is generic for the identified goods or services, then the mark as a whole is generic and unregistrable. Stated differently, a generic term is not transformed into a registrable mark simply by joining it with a toll-free telephone area code which itself is devoid of source-indicating significance.
Supra at 1913.

Under this analysis, the Board found the designation 1-888-M-A-T-R-E-S-S to be generic and unregistrable, in that it consisted merely of a telephone area code and the legal equivalent of the generic term "mattress." Insofar as applicant's specific services were concerned, the Board stated

[w]e further find that the genus of the services involved in this case is that of "telephone shop-at-home retail mattress sales" and that M-A-T-R-E-S-S, the legal equivalent of the word "mattress," would be understood by the relevant purchasing public to refer primarily to that genus of services.
Supra at 1914.

We agree with the Examining Attorney that the Board's rulings in *Dial A Mattress* are applicable here. Applicant is also seeking in this application to register a mark

consisting solely of the combination of a toll-free telephone area code and a generic term for the identified services. In the same manner that 1-888-M-A-T-R-E-S-S was found to be unregistrable for telephone shop-at-home retail mattress sales, we find 1-800-THE SOFA to be unregistrable for applicant's telephone shop-at-home services for the sale of convertible bedding.²

Applying the two-step *Ginn* test, as the Board did in the *Dial A Mattress* case, we find that the genus of services involved here is telephone shop-at-home sales of convertible bedding, which in turn has been specifically defined as including convertible sofas, convertible couches, convertible divans and sofa-beds. Inasmuch as this "convertible bedding" falls within the general category of "sofas," the relevant purchasing public would understand the term THE SOFA as referring primarily to this particular genus of goods and to shop-at-home services offering these goods. The combination of a telephone area code which has no source-indicating significance in itself with a generic name for the particular type of goods being offered for sale does not result in a mark which is capable

² Although the identification of applicant's services is somewhat awkward, we find the record as a whole confirms that applicant is seeking registration of its mark for telephone shop-at-home services.

of distinguishing applicant's shop-at-home services from those of others in the field.

Applicant strongly contends that its mark must be considered in its entirety and not dissected into its component parts. Applicant acknowledges that in general a designation which is generic for a type of goods is also generic for "retail store" services featuring those goods, but argues that its mark is not "sofa" alone.³ Applicant insists that 1-800-THE SOFA as a whole does not primarily refer to any class of services, but rather serves to uniquely identify applicant as the source of these services.

We believe the Board fully addressed the question of whether the addition of a toll-free telephone area code to generic matter results in a registrable mark in its *Dial A Mattress* decision. Applicant's arguments here raise no new issues. In *Dial A Mattress*, the Board openly rejected the reasoning of the Second Circuit Court of Appeals in *Dial-A-Mattress Franchising Corp. v. Page*, 880 F.2d 675, 11 USPQ2d 1644 ((2d Cir. 1989), in which protection was afforded to a telephone number comprised of a generic term. We see no reason to do otherwise. Although applicant argues that

³ Applicant has stated that it is willing to disclaim the term SOFA.

even the decision in *Dranoff-Perlstein Associates v. Sklar*, 967 F.2d 852, 23 USPQ2d 1174 (3d Cir. 1992), which was endorsed by the Board, supports its present position, we cannot agree. In the *Dranoff* case, the mark involved was INJURY-1 and the court, after holding that the term INJURY, as used in the mark, was generic, pointed out that the mark as a whole was INJURY-1 and not just the generic term INJURY. Thus, for purposes of determining secondary meaning and likelihood of confusion, the mark as a whole had to be taken into consideration. Here, there is no additional component in the mark as a whole which might be capable of serving as an indication of source.

Even though, as applicant points out, the literal portion of its mark is THE SOFA and not just SOFA, we find no source-indicating significance in the presence of the additional term THE. We view the inclusion of the definite article as no more than further reference to the particular type of goods being sold, rather than to any single source thereof. See *In re The Computer Store, Inc.*, 211 USPQ72 (TTAB 1981) (THE COMPUTER STORE common descriptive name for computer and computer book outlet services). We consider the definite article "the" as falling within the same category as the entity designations "Inc." or "Co.," both of which have been found devoid of source-indicating

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significance and insufficient to transform otherwise generic matter into a registrable mark. See *In re Paint Products Co.*, 8 USPQ2d 1863 (TTAB 1988); *In re E.I. Kane, Inc.*, 221 USPQ 1203 (TTAB 1984).

Considering applicant's proposed mark 1-800-THE SOFA as a whole, we find it to be generic and incapable of identifying applicant's services and distinguishing them from those of others.

Decision: The refusal to register under Section 23 is affirmed.

E. J. Seeherman

G. D. Hohein

H. R. Wendel

Administrative Trademark Judges,
Trademark Trial and Appeal Board

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